

### **REMARKS**

In the first Office Action claims 1-17 were rejected variously under 35 U.S.C. § 112, 35 U.S.C. § 101, and 35 U.S.C. § 103. The claims have been amended to overcome the 35 U.S.C. § 112 rejection and to provide further antecedent corrections. It is respectfully requested that the Primary Examiner reconsider the claims based on these amendments and the following remarks.

#### **35 U.S.C. § 112:**

Claim 1 and its dependent claims are rejected as lacking proper antecedents. Claim 1, line 20 has been amended to provide a proper antecedent for “the at least one response” and claim 3 for “said presenting” and “the operation of a randomly set timer.” The Primary Examiner is thanked for pointing this out. Claim 1 and its dependent claims are in condition for allowance and such allowance is respectfully requested. Additional amendments are made to correct other antecedents and as set forth below.

#### **35 U.S.C. § 101:**

Claims 1-17 are rejected as being directed to non-statutory subject matter. It is respectfully maintained that the claims are statutory subject matter and do not, as a whole encompass or claim living subject matter or a human being. The Primary Examiner's attention is directed to U.S. Patent No. 6,705,613 which contains a statutory subject matter claim 1 that claims method step interactions between a poker game and human beings (i.e., a dealer and players). The pending claims 1 and 10 recite significant structure in the method steps such as a casino game, receiving a wager in the casino game, paying the player a game of chance award, ending the casino game, presenting to the player in a display, etc. However, claims 1 and 10 have been amended to remove reference to “a player” from the preamble. In addition, claims 1 and 10 have been further amended to recite that the various method steps occur in the casino game. Claim 5 is to a physical casino game and does not encompass a human being. All claims are directed to statutory subject matter.

**35 U.S.C. §103:**

Claims 1-17 are rejected as being unpatentable over Demar in view of Walker and the "Feud History." It is respectfully maintained that the claims are patentable over the cited references when the independent claims are read as a whole. Bonus games are conventional in the casino industry, but improvements to existing bonus games and bonus games constitute patentable subject matter. It is extremely rare for a new patent to claim other than a combination of old elements. Demar shows a bonus game occurring when a random symbol occurs on the reel slot outcome. The Demar bonus game is then played. The claimed invention provides a novel and non-obvious bonus game and, as admitted by the Primary Examiner, one that is not found in Demar.

Walker does not teach a bonus game. Walker only teaches that correct answers to trivia questions **enhance** reel slot payouts **only when** winning combinations occur in the play of the reel slots. Walker requires a player to answer a trivia question before **each spin** of a slot game completes (or in a predetermined time period thereafter). Indeed, Walker requires the spin reel button to be pushed (step 1112 in Figure 11A) before retrieving the next question from the database (step 1128 in Figure 11B). Every Walker spin displays another question. For those spins that do not randomly provide the player with a win in the reels, any correct answer to the displayed question is a waste of the player's time (and this happens often, see column 8, lines 50-55 for a discussion of 8,570 reel outcomes resulting in non-winning combinations out of 10,648 total combinations). But, when a winning combination is hit and a correct answer given, then an enhanced payout is provided. Walker penalizes the player when the player incorrectly answers (the payout is reduced) so the player is encouraged not to guess (a non-answer results in a payoff). No such penalty is found in the present invention. Guessing in the present invention is encouraged as the player may guess an answer having a higher number of respondents answer. This is not a bonus game of the type claimed (i.e., upon the occurrence of a random bonus event as found in claim 1). In Walker, the player **MUST** answer with every reel spin to be eligible for enhanced payouts. This is not the claimed invention. Also, the claimed invention in claims 1, 5 and 10 recite that the bonus award is separate from the payoffs in the underlying game of chance and that the underlying game of chance ends when a winning combination is obtained therein. In the claimed invention, the bonus award is separate from the awards in the slot game. Walker

has no such teachings. Walker has no bonus game as every reel spin requires an answer to a question and only when the player wins in the reel spin does the answer modify the reel spin award either up if correct or down if incorrect (see Figure 10).

The FAMILY FEUD game was presented in the specification starting at paragraph 0071 as a popular game show. However, a reference for the "Feud History" is not provided in the Office Action so the cited "Feud History" cannot be analyzed under this rejection. It is requested that the Primary Examiner provide a "Feud History" reference. It is maintained that the claimed invention is patentably distinct. In claims 1 and 5, the casino game pays the player a bonus award as a function of how many people answered each displayed answer in the presented question. This is not taught in the FAMILY FEUD game where individual players of a family are pitted against individual players of another family. In the FAMILY FEUD game, two families play against each other, in the pending claim only a player inputs at least one answer. An individual player of a family in the FAMILY FEUD game does not get a choice of answers, but guesses an answer. Claim 10 provides a bogus answer in the presented answers. Bogus answers are not found as a selection in the FAMILY FEUD game.

The Federal Circuit mandates in In re Bruce Beasley, \_\_\_ USPQ 2d \_\_\_ (Dec. 7, 2004) that: "Given the 'subtle but powerful attraction of a hindsight-based obviousness analysis,' we require a 'rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.'" Id. at page 7. There are no factual statements in the four corners of the rejection providing substantial evidence of a motivation to combine Demar with either Walker or the "Feud History." Id. Walker only teaches enhancing (or reducing) winning payouts in a reel slot game by requiring the player to play a simultaneous trivia game for every reel spin. Walker is not a bonus game as taught by Demar. As Demar emphatically states: "A principle feature of the present invention is the structure of the bonus game. A player must play the base game until he qualifies for the bonus game." Column 2, lines 17-20. Demar teaches away from Walker which provides the trivia question **with every spin**. Nor, can the "Feud History" be combined as there is no reference to be analyzed for a motivation or teaching to combine. Allegations that a reference so teaches without more is insufficient. Id. at page 8. The provision of trivia to enhance the payoffs cannot be substituted for the bonus game of Demar as there is no motivation to do so. The present invention provides an exciting new bonus game to players

that provides separate awards and which varies in value as a function of how many people responded to a survey question. The particular problem solved is an exciting knowledge-based casino bonus game of the type claimed. Demar recognizes that the player thrill and excitement are needed for casinos to make profit (see Demar's Background of the Invention). The claimed invention provides a novel solution to these needs.

Independent Claims 1, 5 and 10 are patentably distinct and are in condition for allowance. Dependent claims 4 and 11 "having a value in credits equal to a number of a number of respondents" are not found in any reference cited.

All claims are in condition for allowance and such allowance is respectfully requested.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

DORR, CARSON, SLOAN, BIRNEY & KRAMER, P.C.

Date: 2/9/05

By: Robert C. Dorr  
Robert C. Dorr  
Reg. No. 27,782  
3010 East 6th Avenue  
Denver, Colorado 80206  
(303) 333-3010